

**REMARKS****Claim Status**

The Examiner has vacated the Notice of Allowance issued on May 5, 2006 and has reopened prosecution on the merits. Claims 21, 28, 40, 43, 102-104, 106-117, and 119-126 remain allowed in view of the present office action. Claims 1-11, 13, 18, 20, and 99-101 stand rejected.

Applicants note that rejected claims 99-101 depend, directly or indirectly, from allowed and independent claim 21. Applicants respectfully request that the Examiner reconsider the status of claims 99-101 and allow these claims as well.

**Amendments to the Claims**

Applicants have canceled claims 1-11, 13, 18, and 20 without prejudice. Amendments to the claims are made solely to expedite prosecution. Applicants reserve the right to prosecute claims of similar or differing scope and reserve the right to pursue the subject matter of the claims as originally filed and originally presented in future applications. Applicants have introduced no new matter.

**Claim Rejections****35 U.S.C. § 112, first paragraph**

Claims 8 and 18 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description and enablement requirements. The claims recite a DNA binding domain that binds to a recognition sequence that occurs at a position in a mammalian genome within 500 base pairs of an allele that is known to contribute to a genetic disorder. The Examiner contends that the specification does not teach that Applicants were in possession of all such binding domains. The Examiner concludes that Applicants were not in possession of the embodiments of the instant claims and therefore the specification does not satisfy the written description requirement. The Examiner also argues that Applicants have not taught the skilled artisan all sequences that are within 500 base pairs of an allele known to

contribute to a genetic disorder. Thus, according to the Examiner, undue experimentation would be required to practice claims 8 and 18.

Applicants traverse these rejections. However, solely to expedite prosecution, Applicants have canceled claims 8 and 18, thereby rendering the rejections moot. Applicants' amendments are not made in acquiescence to the Examiner's remarks and Applicants expressly reserve the right to pursue the subject matter of the canceled claims in future applications.

### **35 U.S.C. §102(b)**

Claims 1-11, 13, 18, and 20 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Chandrasegaran (AI, cited by Applicants). The Examiner contends that Chandrasegaran recites a chimeric nuclease comprising three zinc finger domains and the cleavage domain of FokI. The Examiner further contends that Chandrasegaran recites chimeric nucleases comprising a nuclear localization signal. Regarding the claim limitation that the recognition sequence occurs within 500 base pairs of an allele that is known to contribute to a genetic disorder, the Examiner argues that this claim limitation is inherent and thus does not distinguish the claimed invention from Chandrasegaran.

Claims 1, 2, 8, and 13 further stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Kelly et al. (A, U.S. Patent 6,046,036). The Examiner contends that Kelly et al. recite a fusion protein with endonuclease activity that contains a nuclear localization signal and a DNA binding domain. Claims 1, 9, and 13 also stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Geisen et al. (2000 J. Gen. Virol. 81: 2231-2244). According to the Examiner, Geisen et al. recite a polypeptide comprising a DNA binding domain, a cleavage domain, and a nuclear localization signal. The Examiner argues the polypeptide is a chimeric protein since Figure 1C of Geisen et al. shows the polypeptide fused to a His tag.

Applicants traverse the rejections under 35 U.S.C. § 102(b) and based on Chandrasegaran, Kelly et al., and Geisen et al. However, solely to expedite prosecution, Applicants have canceled claims 1-11, 13, 18, and 20 without prejudice, thereby rendering the rejections moot. Applicants' amendments are not made in acquiescence to the Examiner's

remarks and Applicants expressly reserve the right to pursue the subject matter of the canceled claims in future applications.

**35 U.S.C. §102(b)**

Claims 1-11, 13, 18, 20, and 99-101 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Chandrasegaran. The Examiner contends that the use of promoters and viral vectors would have been obvious to the skilled artisan given the state of the prior art. Applicants traverse the rejection but have nonetheless canceled claims 1-11, 13, 18, and 20 without prejudice. Applicants contend that claims 99-101 are patentable since these claims directly or indirectly depend from independent and allowed claim 21. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 99-101.

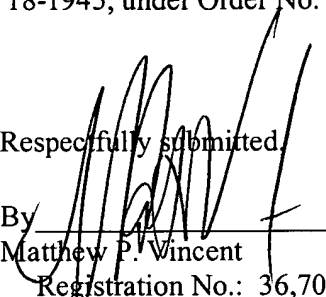
Applicants have amended the claims solely to expedite prosecution. The claim amendments should not be viewed as a submission to the rejections and the Examiner's remarks. Applicants expressly reserve the right to prosecute claims of similar or differing scope and to pursue the subject matter of the canceled claims in future applications.

**Conclusion**

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to Deposit Account No. 18-1945, under Order No. CTCH-P01-016 from which the undersigned is authorized to draw.

Dated: January 8, 2007

Respectfully submitted,

By   
Matthew P. Vincent

Registration No.: 36,709  
ROPES & GRAY LLP  
One International Place  
Boston, Massachusetts 02110-2624  
(617) 951-7000  
(617) 951-7050 (Fax)  
Attorneys/Agents For Applicant